<u>REMARKS</u>

This Supplemental Amendment is being filed as a result of discussions during the telephone interview of March 10, 2009. At the outset, the undersigned attorney, William A. Blake, would like to thank Examiner Siegfried Chencinski and Primary Examiner Narayanswamy Subramanian, for the courtesy of granting and participating in the telephone interview. During the interview, Mr. Blake summarized the key features of the present invention which Mr. Blake asserted distinguish the claimed invention over Applicant Ernest Thiessen's previous patent, US 5,495,412. Mr. Blake then addressed the 35 U.S.C. 101 issue that was raised in the previous Office Action of August 13, 2008, but asserted was not clearly stated in the Office Action. Each of these issues is fully discussed in the Amendment of February 13, 2009 and need not be repeated here.

However, during the interview, Examiner Subramanian raised an issue regarding the language of claim 29 that was not raised in the Office Action and addresses both Examiners' concerns about the 35 U.S.C. 101 issue. In particular, Examiner Subramanian questioned whether the language of now cancelled claim 29 could read on an Internet chat session in which the suggestions recited as being generated by the computer could actually be generated by a person entering the suggestions into the computer. Examiner Subramanian then suggested that phrases such as "automatically" or "without human intervention" be added to the claims to rule out this possibility. However, Examiner Subramanian also questioned whether such changes would be supported by the specification.

In light of the suggestions made by Examiner Subramanian, claims 18-29 have now been cancelled and replaced with new claims 30-34, which Applicants respectfully submit address the

issues raised by Examiners Subramanian and Chencinski and clearly satisfy the requirements of 35 U.S.C. 101.

With specific reference to claim 30, the computer based method is now recited as being carried out by a neutral site computer, which is programmed to carry out the recited steps of the method. In so doing, the neutral site computer communicates with first and second party computers. Claim 30 specifically recites that the neutral site computer carries out the steps of:

> receiving from each of said party computers, a range of values and preferences associated with said at least one issue to be resolved;
>
> determining from said preferences a combined bargaining range of values from least preferred outcome to most preferred outcome for each party for said at least one issue to be resolved;
>
> automatically generating a plurality of suggestions that seek to provide a corresponding plurality of potential resolutions to the negotiation, each of said suggestions providing a proposed value for said at least one issue to be resolved, each of which falls within the said combined bargaining range for said at least one issue;
>
> sending each of said suggestions to each of said party computers;
>
> holding in confidence in said neutral site computer any acceptance indication received from any of said party computers that the party associated with that party computer accepts one or more of said suggestions; and
>
> when said neutral site computer determines from all received acceptance indications that all of the parties accept at least one of the same of said suggestions, automatically sending an agreement indication to each of said party computers that the parties have reached an agreement.

Although the word "automatically" does not literally appear in the specification, Applicants respectfully submit that the description provides implied support for the term. As set

6

forth in MPEP § 2163, to comply with the written description requirement of 35 U.S.C. 112, paragraph 1, each claim limitation must be expressly, **implicitly, or inherently** supported in the originally filed disclosure. MPEP § 2163 (I) (B) specifically states "[w]hile there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure." This statement unequivocally means that the actual terms used in the claims need not be expressly present in the specification as long as the terms are supported through implicit or inherent disclosure.

Applicants respectfully submit that it is clear from the description that the suggestions generated by the neutral site computer are generated automatically without human intervention. For example, in paragraph 15 on page 5, it is stated that "[p]ackages that are generated by the system are done so using optimization techniques, the preferred method using standard mixed-integer linear programming techniques to solve an appropriate optimization problem that takes into account the preference information of the parties and obeys any shared or private constraints that have been defined." Later in the same paragraph, it is stated "[f]or maximum security of all party's confidential information, a separate computer system located at a neutral site can be connected to each individual party's computer system. In this case, packages are generated at the neutral site and transmitted back to each party's own computer system. Encryption is used to maintain transmission security. **This entire system may be automated** in repetitive negotiations in which the computer systems controlled by the parties may derive required input information from simulation models rather than that information having to be explicitly entered each time." (emphasis added)

Clearly, the language in these two passages, as well as in many other of the passages in the detailed escription, implies that the neutral site computer (i.e. system) is programmed to

generate the so-called packages (suggestions) automatically and that by no means are the packages generated by a person by hand, for example. Further, the second passage indicates that the entire system, including the party computers could be automated, which again implies that at least the neutral site computer is automated. Applicants therefore respectfully submit that the description provides clear support for use of the term "automatically" in claim 30, even though the description does not provide literal support for the term.

Claim 30 has also been worded to specify that the neutral site computer "is programmed to carry out" the recited steps. This also avoids any confusion with an Internet chat session in which the neutral site computer would, at most, be programmed to communicate information entered manually by the parties, but by no means could be said to be programmed to generate the actual suggestions based on the information received from the party computers.

Finally, to avoid any possibility that the claimed method could work differently depending on the parties, claim 30 has also been drafted to specify that the neutral site computer keeps acceptances of suggestions received from any party hidden until the computer determines that all of the parties have accepted the same suggestion, at which point the neutral site computer sends an indication to the party computers that an agreement has been reached. Thus, the recited method operates the same way no matter what dispute is being resolved. Obviously, claim 30 is limited to scenarios where each of the parties first defines bargaining ranges that at least enable the neutral site computer to generate the plurality of suggestions and second are willing to accept at least one of the same suggestions generated by the neutral site computer. If they are not, then claim 30 does not cover that negotiation.

In view of the forgoing, Applicants respectfully submit that claim 30 clearly satisfies the requirements of 35 U.S.C. 101 by providing a new and useful computer based method that, when used by parties involved in a negotiation, provides a predictable, tangible and concrete result.

Regarding patentability, claim 30 still retains the key features of the invention which define over US 5,495,412 to Thiessen. These are generation of a plurality of proposed suggestions to the negotiation, each of which is provided to the parties; receiving from and holding in confidence an indication that any of the parties is willing to accept one or more of said suggestions; and, generating an indication that an agreement has been reached when all of the parties have indicated that they accept the same one of said suggestions. Thus claim 30 is clearly patentable over the prior art of record. This also applies to clams 31-34, which are directly or indirectly dependent on clam 30.

With reference to the dependent claims, claim 31 is dependent on claim 30, and specifies that a plurality of issues is to be resolved. In addition, claim 31 specifies that the neutral site computer determines from the preferences, the importance of the issues to the parties and then assigns a rating to the suggestion. This feature helps the neutral site computer generate suggestions that take into account the relative importance of the issues to each of the parties and thereby comprise suggestions that are more likely to be acceptable to the parties.

Claims 32 and 33 are dependent on claims 31 and 30, respectively, and recite the graphical interface for each of the party computers. Finally, claim 34 specifies that the neutral site computer generates proposed suggestions that are based on previously generated suggestions and is applicable to an embodiment of the invention in which multiple sessions may be employed by the parties using the method.

In view of the foregoing, Applicants respectfully submit that new claim 30-34 clearly define a computer based method that provides a predictable, tangible concrete result and thus satisfy the statutory requirements of 35 U.S.C. 101. In addition, these claims clearly overcome the other rejections set forth in the Office Action for the reasons presented in support of cancelled claims 18-29 in the Amendment filed on February 13, 2009. Accordingly, Applicants respectfully request favorable reconsideration of the application.

Respectfully Submitted,

By _____/wab/_____

William A. Blake
Reg. No. 30,548

JONES, TULLAR & COOPER, P.C.
P.O. Box 2266, Eads Station
Arlington, VA 22202
Phone (703) 415-1500 Fax (703) 415-1508
Dated: March 20, 2009